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EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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SUPPLEMENTAL

EXAMINER'S ANSWER

1. This is in response to the brief on appeal filed January 24, 2001.

Status of Claims

2. The statement of the status of claims 28-59 contained in the brief is correct.
3. The statement of the status of the claims 1-27 contained in the brief is incorrect. A correct statement of the status of the claims is as follows: claims 1-27 would be allowed if any of claims 28-59 are allowed. Since claims 1-27 have not been amended, recapture does not apply to these claims.

Status of Amendments After Final

4. The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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Summary of Invention

5. The summary of invention contained in the brief is correct.

Issues

6. The appellant's statement of the issues in the brief is substantially correct.
The changes are as follows: since claims 1-27 have not been amended, recapture does not apply to these claims. Recapture applies to claims 28-59.

Grouping of Claims

7. The rejection of claims 1-59 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Claims Appealed

8. The copy of the appealed claims contained in the Appendix to the brief is correct.

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Prior Art of Record

9. No prior art is relied upon by the examiner in the rejection of the claims under appeal.

No new prior art has been applied in this examiner's answer.

Grounds of Rejection

10. The following ground(s) of rejection are applicable to the appealed claims:

Claims 28-59 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. V. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. V. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

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application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by filing of the present reissue application.

Claim 28 was rejected as being anticipated by Darnell et al in serial No. 07/978272. Applicant argued on page 21 in amendment A in serial No. 07/978272 that the Darnell et al patent does not teach “an event sensor that determines when a selected trigger event involving the vehicle has occurred and issuing a sensor output signal when that event occurs; controller means, connected to the GPS receiver/processor and to the event sensor, for receiving the event sensor output signal and, in response thereto, for issuing a first output signal that is received by the GPS receiver/processor that commands the receiver/processor to determine and issue as an output signal the present location of the receiver/processor, and for receiving the receiver/processor output signal representing present location of the receiver/processor and issuing this present location information as a second output signal”.

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Page 21 in amendment A in Serial No. 07/978272 states: “(1) The Darnell et al user location system requires that GPS unit always be activated and that the associated cellular unit always be transmitting the present location of the user who carries that GPS unit. In the invention recited in claims 27-30 of the patent application, a GPS or other location determining unit and a cellular means are carried on a vehicle, but the combined location determining unit and cellular means are activated only when a receiver carried on the vehicle receives a vehicle location or paging request signal from a central station. The electrical current or power supplied by a power supply for this combination is thus conserved through maintenance of the system in a “sleep mode” most of the time. The system is activated only when (a) the vehicle is moved in an unauthorized manner or (b) some other specific event occurs, as sensed by an event sensor located on or adjacent to the vehicle.”

Claim 28 recited in serial No. 07/978272 was allowed in view of the limitation recited above. Any reissue claim must have this limitation, since it was this limitation that the record (page 21 in amendment A) showed was the reason claim

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28 was allowed and by arguing this limitation, applicant surrendered any claim lacking this limitation. This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 1 was combined with the subject matter of dependent claim 11 to form independent claim 32. As a result the subject matter of dependent claim 11 was the reason independent claim 32 was allowed. Any reissue claim must have the limitation of dependent claim 11, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 32 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 11.

Dependent claim 11 states: "The method of claim 1, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of gyroscopes and associated vehicle angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular orientation of said vehicle; a vehicle velocity sensor to determine and issue an output signal indicating the present velocity of said vehicle; and a receiver/processor

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that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No.

08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 1 was combined with the subject matter of dependent claim 12 to form independent claim 33. As a result the subject matter of dependent claim 12 was the reason independent claim 33 was allowed. Any reissue claim must have the limitation of dependent claim 12, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 33 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 12.

Dependent claim 12 states: “The method of claim 1, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of local magnetic field angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular orientation of said vehicle; a vehicle velocity sensor to determine and issue an output signal indicating the present

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velocity of said vehicle; and a receiver/processor that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 13 was combined with the subject matter of dependent claim 25 to form independent claim 35. As a result the subject matter of dependent claim 25 was the reason independent claim 35 was allowed. Any reissue claim must have the limitation of dependent claim 25, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 35 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 25.

Dependent claim 25 states: “The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of gyroscopes and associated vehicle angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular

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orientation of said vehicle; a vehicle velocity sensor to determine and issue an output signal indicating the present velocity of said vehicle; and a receiver/processor that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No..

08/862039.

In amendment A in serial No. 07/978272, the subject matter of independent claim 13 was combined with the subject matter of dependent claim 26 to form independent claim 36. As a result the subject matter of dependent claim 26 was the reason independent claim 36 was allowed. Any reissue claim must have the limitation of dependent claim 26, since it was this limitation that the record (amendment A in serial No. 07/978272) shows was the reason claim 36 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 26.

Dependent claim 26 states: “The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to comprise: a plurality of local

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magnetic field angular orientation sensors attached to said vehicle to determine and issue output signals indicating the present angular orientation of said vehicle; a vehicle velocity sensor to determine and issue and output signal indicating the present velocity of said vehicle; and a receiver/processor that receives the output signals from the vehicle angular orientation sensors and the vehicle velocity sensor and determines the present location of said vehicle from these signals.” This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment B in serial No. 07/978272, the subject matter of independent claim 31 was combined with the subject matter of dependent claim 10 to form independent claim 39. As a result the subject matter of dependent claim 10 was the reason independent claim 39 was allowed. Any reissue claim must have the limitation of dependent claim 10, since it was this limitation that the record (amendment B in serial No. 07/978272) shows was the reason claim 39 was allowed and applicant surrendered any claim lacking the limitation recited in dependent claim 10.

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Dependent claim 10 states: "The method of claim 1, further comprising the step of choosing said vehicle location receiver/processor to be a LORAN signal receiver/processor that receives time-coded LORAN signals from a plurality of LORAN signal transmitters and determines said vehicle location from these signals." This limitation is not present in claims 28-59 in serial No. 08/862039.

In amendment B in serial No. 07/978272, the subject matter of independent claim 34 was combined with the subject matter of dependent claims 23 and 24 to form independent claim 41. As a result the subject matter of dependent claims 23 and 24 was the reason independent claim 41 was allowed. Any reissue claim must have the limitations of dependent claims 23 and 24, since it was these limitations that the record (amendment B in serial No. 07/978272) shows was the reason claim 41 was allowed and applicant surrendered any claim lacking the limitations recited in dependent claims 23 and 24.

Dependent claim 23 states: "The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to be a GPS signal

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receiver/processor that receives time-coded GPS signals from one or more satellites and determines said vehicle location from these signals.”

Dependent claim 24 states: “The method of claim 13, further comprising the step of choosing said vehicle location receiver/processor to be a LORAN signal receiver/processor that receives time-coded LORAN signals from a plurality of LORAN signal transmitters and determines said vehicle location from these signals.”

These limitations are not present in claims 28-59 in serial No. 08/862039.

Claims 28-59 recapture claimed subject matter deliberately canceled in application serial Number 07/978,272.

For example:

Claims 28-33 in serial Number 08/862,039 recapture subject matter from canceled claim 31 in serial Number 07/978,272.

Claim 31 in the patent, which recited the method of determining the location of the vehicle was rejected and canceled (combined with claim 10 to form allowable claim

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39, renumbered as claim 7). Claim 31 contained detailed structure. Newly filed claim 28 attempts to recapture subject matter canceled (the method without the limitations of claim 10) but also broadened the claims in aspect directly related to the rejection of claim 31 in the in the patent file. Likewise claim 27, in the patent, recited apparatus of a similar scope to that of claim 31 and was canceled. Claim 30 of the reissue recaptures such canceled claim language, and additionally broadens that subject matter in an aspect directly related to the rejection of claim 27 of the patent file.

In the amendment filed January 27, 2000, Applicant indicated that none of the claims are broader in all aspects than the canceled claims, and are in fact narrower in some aspects. Detailed justification of this position was requested.

With regard to the examples recited above, claim 31 in the patent application was canceled (combined with claim 10 to form allowable claim 39, renumbered as claim 7). Comparing new claim 28 to canceled claim 31; it is broader in all aspects, The patented claim 7 required the subject matter of claim 10 to be allowable. Therefore Applicant "surrendered" claimed subject matter not including the limitations of claim 10. Applicant argues that each claim is allowable over the references for

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various structural reasons (limitations). These limitations are what make the claims allowable and are required to remain in the reissue claims as the Applicant has “surrendered” subject matter not containing the limitations.

There are two ways to determine recapture: by comparison to canceled claims, and by determining what limitations made the patent claims allowable. A reissue claim can not be broader than a canceled claim in all aspects, and all reissue claims must retain at least one of the reasons (limitations) which made the patent claims allowable.

Response to Argument

11. The Appellant has grouped the claims on appeal (1-59) in three categories, A, B, and C.

Group A: patented claims 1-27. Since these claims have not been amended or changed, the recapture doctrine does not apply.

Group B: claims 28-49, 54, 55, 58, and 59. These claims recite a communications device capable of operation independent of a paging request responder.

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Group C: claims 50-53, 56, and 57. These claims recite a noncellular paging request responder.

The Group B claims (claim 54 for example) have been broadened since the patented claims 1-27 recite a communication device which is coupled to the output of the paging device. To function, the communication device must receive the output of the paging device. Claims 1-27 do not recite a communications device capable of operation independent of a paging request responder. As a result, the Group B claims (claim 54 for example) are broader than patented claims 1-27. Further evidence of broadening can be demonstrated since various elements recited the patented claims 1-27 are not present in the Group B reissue claims (28-49, 54, 55, 58, and 59). For example: "controller means, connected to the GPS receiver/processor and to the event sensor, for receiving the event sensor output signal and, in response thereto, for issuing a first output signal that is received by the GPS receiver/processor that commands the receiver/processor to determine and issue as an output signal the present location of the receiver/processor, and for receiving the receiver/processor output signal representing present location of the

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receiver/processor and issuing this present location information as a second output signal” (claim 1), “A plurality of gyroscopes and associated vehicle angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle” (claim 3), “a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle” (claim 4), “a plurality of gyroscopes and associated vehicle angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle” (claim 5), “a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle”, (claim 6), “providing a vehicle with a LORAN signal antenna and receiver/processor, connected to the antenna, where the antenna and receiver/processor receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the location of a selected vehicle location from these signals” (claim 7), and “providing a vehicle with a vehicle location signal antenna and a receiver/processor, connected to the antenna, where the vehicle location signal antenna and

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receiver/processor are drawn from the class consisting of (i) a GPS signal antenna and a receiver/processor that receive time-coded GPS signals from one or more satellite and determine the present location of a selected vehicle from these signals and (ii) a LORAN signal antenna and receiver/processor that receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the present location of a selected vehicle from these signals” (claim 17), are not present in the Group B claims (28-49, 54, 55, 58, and 59).

The Group B claims (claim 54 for example) relate to subject matter that Appellant previously surrendered during the prosecution of the application. Claim 38 found in application 07/978,272 recites a communication device capable of operating independently of a paging request responder since the communication means recited in claim 38 is responsive to an event sensor output signal, not a paging signal. Since claim 38 was canceled in the amendment filed June 22, 1994, the “communications device capable of operation independent of a paging request responder” subject matter found in the Group B claims (28-49, 54, 55, 58, and 59) has been surrendered. The same analysis that applies to claim 54 also applies to the rest of

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the claims in Group B (28-49, 55, 58, and 59) since these claims variously contain the “communications device capable of operation independent of a paging request responder” subject matter which was surrendered when claim 38 found in application 07/978,272, was canceled.

The Group C claims (claim 56 for example) have been broadened since the patented claims 1-27 do not recite a noncellular paging request responder. Further evidence of broadening can be demonstrated since various elements recited the patented claims 1-27 are not present in the Group C reissue claims (50-53, 56, and 57). For example: “controller means, connected to the GPS receiver/processor and to the event sensor, for receiving the event sensor output signal and, in response thereto, for issuing a first output signal that is received by the GPS receiver/processor that commands the receiver/processor to determine and issue as an output signal the present location of the receiver/processor, and for receiving the receiver/processor output signal representing present location of the receiver/processor and issuing this present location information as a second output signal” (claim 1), “A plurality of gyroscopes and associated vehicle angular orientation sensors attached to the

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vehicle to determine and issue output signals indicating the present angular orientation of the vehicle” (claim 3), “a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle” (claim 4), “a plurality of gyroscopes and associated vehicle angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle” (claim 5), “a plurality of local magnetic field angular orientation sensors attached to the vehicle to determine and issue output signals indicating the present angular orientation of the vehicle”, (claim 6), “providing a vehicle with a LORAN signal antenna and receiver/processor, connected to the antenna, where the antenna and receiver/processor receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the location of a selected vehicle location from these signals” (claim 7), and “providing a vehicle with a vehicle location signal antenna and a receiver/processor, connected to the antenna, where the vehicle location signal antenna and receiver/processor are drawn from the class consisting of (I) a GPS signal antenna and a receiver/processor that receive time-coded GPS signals from one or more satellite and determine the

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present location of a selected vehicle from these signals and (ii) a LORAN signal antenna and receiver/processor that receive time-coded LORAN signals from a plurality of LORAN signal transmitters and determine the present location of a selected vehicle from these signals” (claim 17), are not present in the Group C claims (50-53, 56, and 57).

The Group C claims (claim 56 for example) relate to subject matter that Appellant previously surrendered during the prosecution of the application. Claim 37 recites a “noncellular paging request responder”. Claim 37 was canceled in the amendment filed June 22, 1994. As a result, the “noncellular paging request responder” subject matter found in the Group C claims (50-53, 56, and 57) has been surrendered. The same analysis that applies to claim 56 also applies to the rest of the claims in Group C (50-53 and 57) since these claims variously contain the “noncellular paging request responder” subject matter which was surrendered when claim 37 found in application 07/978,272, was canceled.

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12. It is the Examiner's contention that the rejection of claims 28-59 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based is correct and should be sustained.

The only issue on appeal is whether claims 28-59 are an improper recapture of broadened claimed subject matter surrendered in the application of the patent upon which the present reissue is based.

The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is **not applicable** to the facts of this appeal. The claims on appeal omit the surrender-generating limitations (i.e., the limitation(s) added and/or argued to define over the art to secure allowance). This is because, in the original application, (A) the specific receiver/processor was added to some claims and (B) the limitation that the combined location determining unit and cellular means are activated only when the receiver on the vehicle receives an incoming request signal was argued to obtain patentability of the claims, and both A and B are omitted from reissue claims 28-59 in their entirety. Therefore, claims 28-59 impermissibly recapture what was previously surrendered as explained in more detail below.

A. Summary of Invention

1. The claims (of both the original patent and the reissue application) are drawn to a method and apparatus for determining the present location of a missing vehicle comprising means mounted on the vehicle to receive location-determining signals from location sensing/transmitting means, and to determine the present location of the vehicle. The system is activated in response to an outside request via an incoming request-signal, and after determining the location of the vehicle, this information is transmitted to a remote location.

B. Original Application (for which the patent was issued) Prosecution History

1. The independent claims 1 and 13, as filed, are drawn to a method of determining the location of the vehicle where the location-determining signals are generated from "location-sensing sensors." Independent claims 27 and 28, as filed, are apparatus claims which included a GPS (Global Positioning System) receiver/processor to receive GPS location-determining signals from location sensing/transmitting means, and to determine the present location of the vehicle.

2. In the first Office action of February 8, 1993, the examiner rejected all of the claims over prior art.

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3. During the subsequent prosecution of the original application, method claims 1 and 13 (as filed) were cancelled and new independent method claims were added with specific types of "location-sensing sensors."

a. Application claim 31 which later became application claim 39 and subsequently independent patent claim 7 was amended to include a LORAN receiver/processor and LORAN transmitters.

b. Application claim 32 which later became independent patent claim 3 was amended to include a gyroscope receiver/processor.

c. Application claim 33 which later became independent patent claim 4 was amended to include a magnetic field angular orientation sensor receiver/processor.

d. Application claim 35 which later became independent patent claim 5 was amended to include a gyroscope receiver/processor.

e. Application claim 36 which later became independent patent claim 6 was amended to include a magnetic field angular orientation sensor receiver/processor.

f. Application claim 34 which later became application claim 41 and subsequently independent patent claim 17 was amended to include a LORAN receiver/processor and a GPS receiver/processor.

4. During the subsequent prosecution of the original application, applicant contested the prior art rejection of the apparatus claim 28 arguing that the claim was distinct because the prior art device was always activated while the claimed device system is normally at rest and is only activated in response to an outside request via an incoming request-signal, and after determining the location of the vehicle, this information is transmitted to a remote location.

5. The examiner allowed all of the claims in a Notice of Allowance mailed November 1, 1994. No reasons for allowance accompanied the notice.

6. During the prosecution of the original application, all of the allowed claims included (A) a specific receiver/processor, which was added during the prosecution, (B) the limitation relied upon in argument to define over the art (although not added by amendment) that the combined location determining unit and cellular means are activated only when the receiver on the vehicle receives a request, or both A and B.

7. At no time were claims present in the parent application which (1) call for a communication device capable of operation independent of a paging request responder, or (2) call for a noncellular paging request responder.

C. Reissue Claims

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1. Claims 1-27 of the reissue application are the original patent claims; they have not been revised in the reissue application.
2. Added reissue claims 28-49, 54-55 and 58-59 all call for a communication device capable of operation independent of a paging request responder.
3. Added reissue claims 50-53 and 56-57 all call for a noncellular paging request responder.
4. None of the claims added by reissue include either (A) a specific receiver/processor or (B) the limitation that the combined location determining unit and cellular means are activated only when the receiver on the vehicle receives a request signal. The reissue claims are, however, limited by the limitations of C2 and C3.

D. Remand Analysis

1. In the present instance, the claims which were rejected by the examiner based on prior art did not contain the (A) the specific receiver/processor. Some of claims did contain the (B) limitation that the combined location determining unit and cellular means are activated only when the receiver on the vehicle receives a request signal, while others did not. To overcome the prior art rejection against the claims, the applicant rewrote some of the claims to add A and also relied in his argument on B. The applicant made the choice of inserting A and/or specifically relying upon B for all of the claims that were allowed in the patent. The applicant chose not to prosecute variations of the original claims not including A or B. At the present, on reissue, applicant is not permitted to completely delete **both** the added limitation A and the relied upon limitation B via claims 28-59. See *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), discussed below. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) for the principle that limitations relied upon to define patentability, although they were not added via amendment in the original application, will establish a surrender of claim subject matter.
2. **Eggert**: The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is not applicable to the facts of this appeal. The claims on appeal omit the surrender-generating limitations (i.e., the limitation(s) added to define over the art to secure allowance). This is because a specific receiver/processor and/or the limitation that the combined location determining unit and cellular means are activated only when the receiver on the vehicle receives a request signal is omitted in its entirety. The reissue claims are limited solely to a communication device capable of operation independent of a paging request responder or a noncellular paging request responder. Therefore, the claims impermissibly recapture what was previously surrendered as set forth the review of the application prosecution history above.
3. On June 17, 2002, in reply to an Order by the BPAI, applicant submitted a supplemental Appeal Brief (paper No. 38) to address issues relating to *Pannu v. Storz Instruments, Inc.*, 258

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F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), which was decided while the application was under appeal. In the supplemental appeal brief, the applicant argues (on page 3) that recapture does not apply because the “independent operation” and “noncellular” limitations added to the reissue claims not only were not contained in any previously canceled claim, and have materially narrowed the claims on appeal.

4. The court in *Pannu* sets forth a “three-step process” for deciding whether the reissue claims impermissibly recapture subject matter surrendered during the prosecution of the parent application:

- a. The first step is to determine whether and in what “aspect” the reissue claims are broader than the patent claims.
- b. The second step is to determine whether the broader aspect of the reissue claim relate to surrendered subject matter.
- c. The third step is to determine whether the reissue claims were materially narrowed in other respects to avoid the recapture rule.

5. As to step one, a specific receiver/processor and/or the limitation that the combined location determining unit and cellular means are activated only when the receiver on the vehicle receives a request signal has been removed from all of the independent claims in the reissue application.

6. As to step two, the “independent operation” and “noncellular” limitations have been added to the reissue claims. Nowhere does the specification teach that the “independent operation” and “noncellular” limitations require the specific type of receiver/processor or “wake-up” mode of operation which were added and/or argued to obtain patentability (and are not contained in claims 28-59 added in the reissue application. Thus, the broadening and narrowing of the claims of the present reissue application do not relate to the same subject matter.

7. As to step three, for the reasons set forth in the step two discussion immediately above, the limitations of the “independent operation” and “noncellular” limitations are narrowing, but do not relate to the broadening via the deletion of the specific receiver/processor and/or the limitation that the combined location determining unit and cellular means are activated only when the receiver on the vehicle receives a request signal.

8. The reissue claims are broader than the original patent claims by not including the surrender-generating limitations of the originally filed application claims. This broadening of the patent claims is barred by the recapture rule even if there is narrowing of the claims not related to the surrender-generating limitations. In view of *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim. This is the understanding of how the shorthand set forth in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 for the broadening/narrowing scenario

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3(a), is applied in light of *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001) both of which pointed out that one should look at the limitation **relied upon to define the invention over the prior art**, and determine if that limitation is omitted in the reissue claims. Note also the statement in *Clement* that every time the claims are narrowed by amendment, subject matter is surrendered. *Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166 ("[E]very time Clement amended his claims, he intentionally omitted or abandoned the claimed subject matter.").¹

In the present instance, similar to the facts in *Pannu*, the applicant has broadened the reissue claims 28-59 in an aspect germane to what was surrendered in response to the prior art rejection, and has not narrowed those claims in the same area. Therefore, the decision in *Pannu* is relevant to the issues on appeal because it provides an actual fact situation in which this scenario was held to be recapture.

13. Any inquiry concerning this communication should be directed to ^{Gregory C.} Theodore

^{Issing}
~~Blum~~ at telephone number (703) ³⁰⁶⁻⁴¹⁵⁶ ~~305-1833~~.

CONF.

TMB

GCI

THT

Theodore M. Blum
THEODORE M. BLUM
PRIMARY EXAMINER

Gregory C. Issing
GREGORY C. ISSING
PRIMARY EXAMINER

¹ This statement that every time the claims are narrowed by amendment, subject matter is surrendered, calls for analyzing reissue claims for whether a key narrowing that was made in the original prosecution has abandoned, i.e., surrendered, subject matter that the patent owner is now seeking to recapture by reissue. Thus, the insertion of a narrowing unrelated to the abandoned (surrendered) claim subject matter that owner is impermissibly trying to recover does not save the claim from the recapture doctrine.